

DISCUSSION OF THE AMENDMENT

The Abstract of the Disclosure has been amended to be one paragraph.

All the claims have been canceled and replaced with new Claims 11-19. Claims 11-13 are drawn to a method comprising coating paper or cardboard with a coating color, and are supported by, and correspond to, original Claims 1-3, with redundant language omitted, and proper Markush language inserted. Claims 14-16 are supported by Claim 10. Claims 17-19 are supported by subject matter omitted from Claims 2 and 3 in the presentation of Claims 12 and 13.

No new matter is believed to have been added by the above amendment. Claims 11-19 are now pending in the application.

REMARKS

Applicants thank the Examiner for the courtesy extended to Applicants attorney during the interview held April 13, 2004, in the above-identified application. During the interview, Applicants' attorney discussed the various issues raised in the Office Action. The discussion is summarized and expanded upon below.

The presently-claimed invention is now drawn to a method comprising coating paper or cardboard with a coating color, wherein the coating color comprises an agent for simultaneously adjusting the water retention of the coating color and its Brookfield viscosity, wherein the agent comprises a copolymer that is water-soluble in a neutral or alkaline medium and comprises various monomer units, as recited in the claims (Claims 11-13 and 17-19); and the paper or cardboard so coated (Claims 14-16).

The rejection of Claims 4-6 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, EP0737728 (Grondin et al), is respectfully traversed. (Applicants note that Grondin et al has a U.S. patent equivalent, i.e., U.S. 5,905,110. Discussion of Grondin et al is with respect to this U.S. equivalent.) Grondin et al relates to copolymer dispersants useful for dispersing for aqueous media of mineral fillers and/or mineral pigments which increase the water resistance of dried or drying films made from filled and/or pigmented aqueous compositions, and the filled and/or pigmented aqueous compositions containing the dispersant (column 1, lines 8-13). A disclosure of the ability to obtain water resistance for a dried or drying film does not suggest the ability to retain water molecules, as in the present invention. Indeed, water retention is different from water resistance. Applicants have discovered that water retention and Brookfield viscosity can be simultaneously adjusted with the presently-recited agents, which use is neither disclosed nor suggested by Grondin et al. Thus, Grondin et al neither discloses nor suggests

the presently-claimed method, or products obtained therefrom. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-10 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, U.S. 4,423,118 (Corbett et al), is respectfully traversed. While Corbett et al discloses a coating color, it appears to be different from the agent recited herein, and Corbett et al neither discloses nor suggests that their coating color can simultaneously adjust both its water retention and its Brookfield viscosity. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-10 under 35 U.S.C. § 103(a) as obvious over Grondin et al and Corbett et al, U.S. 5,843,566 (Miyauchi et al) or U.S. 4,780,500 (Sinka et al), is respectfully traversed. The disclosures and deficiencies of Grondin et al and Corbett et al have been discussed above. Neither Miyauchi et al nor Sinka et al remedy these deficiencies. Accordingly, it is respectfully requested that this rejection be withdrawn.

The provisional rejection of Claims 4-6 under the judicially created doctrine of obviousness-type double patenting over Claims 8-13 of copending Application No. 10/168,389 (copending application) is respectfully traversed. The claims of the copending application neither disclose nor suggest the presently-claimed subject matter. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-10 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that it be withdrawn.

The rejection of Claims 2, 3, 5 and 6 under 35 U.S.C. § 112, first paragraph, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that it be withdrawn.

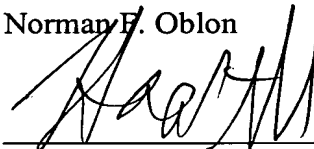
The rejection of Claims 1-3 under 35 U.S.C. § 101 is now moot in view of the cancellation of these claims. Accordingly, it is respectfully requested that the rejection be withdrawn.

The objection to the specification and abstract is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the objection be withdrawn.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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